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| Snell & Wilmer L.L.P., (Barker) One Arizona Center 400 East Van Buren Street Phoenix, AZ 85004-2202 | | | EXAMINER QAYYUM, ZESHAN | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/708,840 | Applicant(s) BEENAU ET AL. | |
| | Examiner ZESHAN QAYYUM | Art Unit 3685 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 29-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 29-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>01/19/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of claims

1. Claims 1, 29-51 have been examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 30 and 51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 30 recites “a transaction biometric sample” in line 4. It is unclear to one of the ordinary skill in the art that is this biometric sample same as recited in claim 1 or different one? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).
4. Claim 33 and 51 recites “accessing the transaction value against at least one of the first account value **or** the third account value” in line 2 and 17. Claims 34 and 51 also recites “accessing the transaction value against the third account value.....condition” in line 4 and 22 respectively. It is unclear to one of the ordinary skill in the art that if accessing the transaction value against first account value then the step in line 4 of claim 34 and line 22 of claim 51 will not occur. (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 29-30, 39, and 41-50 rejected under 35 U.S.C. 103(a) as being unpatentable over Zacharias (US 6494367) in view of Pare (US 5870723).**
6. With respect to claims 1, 29-30 and 48-50, Zacharias discloses: associating different codes (i.e. index numbers) to a card (i.e. supracard) associating, in the database, the first code with a first account having a first account value that is accessible via the card; associating, in the database, the second code with a second account having a second account value that is accessible via the card (See Fig 1 part record A) receiving a transaction request associated with the card, wherein the transaction request comprises a transaction value and transaction code (See column 5, lines 49-67, column 6, lines 1-10, column 7, lines 65-67 and column 8, lines 1-7) comparing the transaction code to the first code and the second code to determine whether to assess the transaction value against the first account or the second account; assessing the transaction value against the first account value in response to the transaction code being associated with the first code (See column 5, lines 49-67, column 6, lines 1-10 and column 7, lines 15-33). Zacharias discloses transaction done by using different codes. Zacharias does not explicitly disclose the use of biometric

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samples instead of codes. Pare discloses transaction done by biometrics samples (See Abstract, column 4, lines 14-67 and column 26, lines 45-51).

Therefore, it would have been obvious to modify Zacharias codes with Pare's biometric samples in order to provide extra security. Zacharias discloses transaction done by card. Zacharias in view of Pare does not explicitly disclose use an RF device instead of a card. The Examiner is taking Official Notice that using RF device are old and well known in the art to perform transaction.

Therefore, it would have been obvious to substitute RF device for the card to obtain predictable result. (Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007)).

7. With respect to claims 39 and 41-43 Zacharias in view of Pare discloses all the limitations as described above. With respect to wherein the second set of account rules is applied to the transaction request in response to the transaction biometric sample data being associated with the second biometric sample data; wherein the first biometric sample data is associated with a first fingerprint of a first digit, and wherein the second biometric sample data is associated with a second fingerprint of a second digit; wherein the first account is a primary account associated with the first biometric sample data, and wherein the third account is a secondary account associated with the first biometric sample data; wherein the second account is a primary account associated with the second biometric sample data, and wherein the fourth account is a secondary account

associated with the second biometric sample data; these are nonfunctional descriptive material because they just describing the data stored in the memory. Therefore, it has been held nonfunctional descriptive material will not distinguish the invention from prior art in term of patentability (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

8. With respect to claim 44 Zacharias in view of Pare discloses all the limitations as described above. Zacharias further discloses: wherein the first account, the second account, the third account and the fourth account individually comprise at least one of a credit account, a debit account, a prepaid account, a loyalty account, a rewards account, or an airline miles account (See Fig 1 part record A and column 7 lines 15-32).
9. With respect to claim 45 Zacharias in view of Pare discloses all the limitations as described above. Zacharias further discloses: wherein the database is associated with at least one of an issuer or an authorized sample receiver (See abstract, column 3, lines 10-25, column 5, lines 4-20 and column 7, lines 1-33).
10. With respect to claims 46-47, Zacharias in view of Pare discloses all the limitations as described above. Pare further discloses: wherein the biometric sensor comprises at least one of a retinal scan sensor, an iris scan sensor, a

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fingerprint sensor, a hand print sensor, a hand geometry sensor, a voice print sensor, a vascular sensor, a facial sensor, an ear sensor, a signature sensor, a keystroke sensor, an olfactory sensor, an auditory emissions sensor, or a DNA sensor; wherein the first biometric sample and the second biometric sample individually comprise a biometric sample characteristic comprising at least one of blood flow, correctly aligned ridges, pressure, motion, body heat, ridge endings, bifurcation, lakes, enclosures, short ridges, dots, spurs, crossovers, pore size, pore location, loops, whorls, or arches (See column 10, lines 44-67, column 11, lines 1-67, column 12, lines 1-67, column 13, lines 1-67 and column 14, lines 1-67).

11. Claims 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Zacharias (US 6494367) in view of Pare (US 5870723) in further view of Marittzen (US 20020073042).

12. With respect to claim 31, Zacharias in view of Pare discloses all the limitations as described above. Zacharias in view of Pare does not explicitly disclose: associating the first biometric sample data with a third account having a third account value. Marittzen discloses associating biometrics with the multiple accounts (See paragraph 00033 and 0038). Therefore, it would have been obvious to one of the ordinary skill in the art at the time invention was made to

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modify Zacharias in view of Pare reference with Marittzen in order for user to remember PIN easily.

13. Claims 32- 34, 37-38 and 40 rejected under 35 U.S.C. 103(a) as being unpatentable over Zacharias (US 6494367) in view of Pare (US 5870723) in further view of Marittzen (US 20020073042) and Walker (US 20050027650).

14. With respect to claim 32-34, 37-38 and 40, Zacharias in view of Pare and in further view of Marittzen discloses all the limitations as described above. Zacharias in view of Pare and in further view of Marittzen does not explicitly disclose: assessing the transaction value against the third account value in response to the transaction value being greater than the first account value; associating the first biometric sample data with a first set of account rules and assessing the transaction value against at least one of the first account value or the third account value in accordance with the first set of account rules. Walker discloses: assessing the transaction value against the third account value in response to the transaction value being greater than the first account value; assessing the transaction value against at least one of the first account value or the third account value in accordance with the first set of account rules (See paragraph 0005 and 0006). Therefore, it would have been obvious to one of the ordinary skill in the art at the time invention was to modify the combination of

Zacharias, Pare and Marittzen references with Walker in order to provide overdraft protection.

15. Claims 35 rejected under 35 U.S.C. 103(a) as being unpatentable over Zacharias (US 6494367) in view of Pare (US 5870723) in further view of Siegel (US 7289970).

16. With respect to claim 35, Zacharias in view of Pare discloses all the limitations as described above. Zacharias in view of Pare does not explicitly disclose: assessing the transaction value against the first account value in response to the transaction request qualifying for loyalty points and in response to the transaction value being less than a maximum value. Siegel discloses: assessing the transaction value against the first account value in response to the transaction request qualifying for loyalty points and in response to the transaction value being less than a maximum value (See column 6, lines 25-59 and column 8, lines 1-11). Therefore, it would have been obvious to one of the ordinary skill in the art at the time invention was made to modify Zacharias in view of Pare reference with Siegel in order to provide incentive to users.

17. Claims 36 rejected under 35 U.S.C. 103(a) as being unpatentable over Zacharias (US 6494367) in view of Pare (US 5870723) in further view of Marittzen (US 20020073042) and Siegel (US 7289970).

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18. With respect to claim 36, Zacharias in view of Pare and in further view of Marittzen discloses all the limitations as described above. Zacharias in view of Pare and in further view of Marittzen does not explicitly disclose: assessing the transaction value against the third account value in response to the transaction request not qualifying for airline miles and in response to the transaction value being greater than a minimum value. Siegel discloses: assessing the transaction value against the third account value in response to the transaction request not qualifying for airline miles and in response to the transaction value being greater than a minimum value. (See column 6, lines 25-59, and column 8, lines 1-11). Therefore, it would have been obvious to one of the ordinary skill in the art at the time invention was made to modify Zacharias in view of Pare and further view of Marittzen reference with Siegel in order to provide incentive to users.

19. Claim 51 rejected under 35 U.S.C. 103(a) as being unpatentable over Zacharias (US 6494367) in view of Pare (US 5870723) in further view of Marittzen (US 20020073042) and Walker (US 20050027650).

20. With respect to claim 51, Zacharias discloses: associating different codes (i.e. index numbers) to a card (i.e. supracard) associating, in the database, the first code with a first account having a first account value that is accessible via the card; associating, in the database, the second code with a second account having a second account value that is accessible via the card (See Fig 1 part record A) receiving a transaction request associated with the card, wherein the

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transaction request comprises a transaction value and transaction code (See column 5, lines 49-67, column 6, lines 1-10, column 7, lines 65-67 and column 8, lines 1-7) comparing the transaction code to the first code and the second code to determine whether to assess the transaction value against the first account or the second account; assessing the transaction value against the first account value in response to the transaction code being associated with the first code (See column 5, lines 49-67, column 6, lines 1-10 and column 7, lines 15-33). Zacharias discloses transaction done by using different codes. Zacharias does not explicitly disclose the use of biometric samples instead of codes. Pare discloses transaction done by biometrics samples (See Abstract, column 4, lines 14-67 and column 26, lines 45-51). Therefore, it would have been obvious to modify Zacharias codes with Pare's biometric samples in order to provide extra security. Zacharias discloses transaction done by card. Zacharias in view of Pare does not explicitly disclose use an RF device instead of a card. The Examiner is taking Official Notice that using RF device are old and well known in the art to perform transaction. Therefore, it would have been obvious to substitute RF device for the card to obtain predictable result. (Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007)).

Zacharias in view of Pare does not explicitly disclose: associating the first biometric sample data with a third account having a third account value.

Marittzen discloses associating biometrics with the multiple accounts (See paragraph 00033 and 0038). Therefore, it would have been obvious to one of the

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ordinary skill in the art at the time invention was made to modify Zacharias in view of Pare reference with Marittzen in order for user to remember PIN easily. Zacharias in view of Pare and in further view of Marittzen does not explicitly disclose: associating the first biometric sample data with a first set of account rules and assessing the transaction value against at least one of the first account value or the third account value in accordance with the first set of account rules; assessing the transaction value against the first account value in response to a first account condition being met; and assessing the transaction value against the third account value in response to a third account condition being met, wherein the first set of account rules includes the first account condition and the third account condition. Walker discloses: associating first account with a first set of account rules and assessing the transaction value against at least one of the first account value or the third account value in accordance with the first set of account rules; assessing the transaction value against the first account value in response to a first account condition being met; and assessing the transaction value against the third account value in response to a third account condition being met, wherein the first set of account rules includes the first account condition and the third account condition (See paragraph 0005 and 00006)

Therefore, it would have been obvious to one of the ordinary skill in the art at the time invention was to modify the combination of Zacharias, Pare and Marittzen references with Walker in order to provide overdraft protection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Nicholson (US 6332128) discloses system and method of providing multiple level discounts on cross marketed products.
- Seder (US 7191156) discloses: digital watermarking system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZESHAN QAYYUM whose telephone number is (571)270-3323. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Z. Q./

Examiner, Art Unit 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685